

### **REMARKS**

This responds to the Office Action mailed on July 1, 2005.

Withdrawn claim 66 is amended, no claims are canceled, and no claims are added; as a result, claims 1-109 are now pending in this application, with claims 1-35 currently pending examination. The amendments to the claims are fully supported by the specification as originally filed. No new matter is introduced. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

Claim 66 is amended including language of claim 12 that includes forming features of the product recited in claim 12.

#### **Information Disclosure Statement**

Applicant submitted an Information Disclosure Statement and a 1449 Form on February 20, 2004. Applicant respectfully requests that an initialed copy of the 1449 Form be returned to Applicant's Representatives to indicate that the cited references have been considered by the Examiner.

#### **In the Specification**

The specification is amended to update the status of U.S. Application Serial No. 09/945,134, from which the instant application is a continuation application. No new matter is introduced.

#### **First §102 Rejection of the Claims**

Claims 1-35 were rejected under 35 U.S.C. § 102(e) for anticipation by Eldridge et al. (U.S. 2005/0023603). Applicant traverses these grounds for rejections of these claims.

The instant application is a continuation application of U.S. Application No. 09/945,395 filed on 30 August 2001, now U.S. Patent No. 6,754,108. Thus, the priority date of the instant application is 30 August 2001. Eldridge et al. (U.S. 2005/0023603) was filed on 30 August 2004 as a divisional application of U.S. Application No. 10/081,818, filed 20 February 2002 as a continuation-in-part of U.S. Application No. 09/943,134, filed 30 August 2001. Therefore, as

shown on the first page of U.S. 2005/0023603, the earliest priority for Eldridge et al. is 30 August 2001, which is not before the priority date of the instant application.

From 35 U.S.C. § 102(e), it is stated

A person shall be entitled to a patent unless —

...

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent

Since Eldridge et al. (U.S. 2005/0023603) and the applications from which it claims priority were not filed before the priority date of the instant application, Applicant submits that application of Eldridge et al. (U.S. 2005/0023603) as prior art with respect to the instant claims is not proper.

Applicant respectfully requests withdrawal of these rejections of claims 1-35, and reconsideration and allowance of these claims.

#### Second §102 Rejection of the Claims

Claim 1 was rejected under 35 U.S.C. § 102(e) for anticipation by Yoshii et al. (U.S. 6,740,928). Applicant traverses these grounds for rejections of these claims.

Applicant cannot find in Yoshii et al. (hereafter Yoshii) a disclosure, a teaching, or a suggestion of a memory adapted to operate a memory cell in a volatile memory mode and in a non-volatile memory mode. In the Office Action, it is stated that “Yoshii et al. disclose ... a storage capacitor coupled to one of the source and drain regions (the examiner is taking official notice that this is well known in the art).” Applicant traverses the use of official notice with respect to a storage capacitor as proffered in the Office Action with respect to the independent claims of the instant application. Applicant submits that taking such official notice does not address the configuration of a storage capacitor as recited in the instant independent claims. Applicant cannot find objective evidence in Yoshii to include a storage capacitor. Further, no objective evidence has been provided in the Office Action to support a basis or reason for the Yoshii reference to include a storage capacitor. Application submits that “Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears*,

*Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Though Yoshii's device, as shown in Figure 33 and referred in the Office Action, may provide a device for use as a memory (*See, Yoshii column 55, lines 33-59, in reference to Figure 33*), Applicant cannot find in Yoshii a disclosure, a teaching, or a suggestion regarding a storage capacitor as recited in claim 1. Therefore, Applicant submits that Yoshii does not disclose, teach, or suggest a memory adapted to operate the memory cell in a volatile memory mode and in a non-volatile memory mode as recited in claim 1.

Thus, Applicant respectfully submits that Yoshii does not teach each and every claim element of claim 1, Yoshii does not teach the identical invention in as complete detail as is contained in claim 1, and Yoshii does not teach each and every claim element arranged as in claim 1. Thus, Applicant submits that Yoshii does not anticipate claim 1 and that claim 1 is patentable over Yoshii for at least the reasons stated above.

Applicant respectfully requests withdrawal of these rejections of claim 1, and reconsideration and allowance of this claim.

#### Withdrawn Claims

Independent claim 36 and 46 include the features of claim 1 and 12, respectively. Applicant submits that the claims dependent to independent 36 and 46 also include the features of claim 1 and 12, respectively. Applicant respectfully requests the rejoinder and allowance of claims 36-55. *See M.P.E.P. 809.*

Independent claims 56 and 79, and claim 66 include features of forming the product of claims 1 and 12, respectively. Applicant submits that the claims dependent to independent claims 56 and 79, and claim 66 include features of forming the product of claims 1 and 12, respectively. Independent claim 90 and 100 include features of operating the product of claim 1 and a species of claim 22, respectively. Applicant submits that the claims dependent to independent claim 90 and 100 include features of operating the product of claim 1 and a species of claim 22, respectively. Applicant respectfully requests the rejoinder and allowance of claims 56-109. *See M.P.E.P. 821.04.*

Thus, Applicant requests rejoinder and allowance of claims 36-109.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2157 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

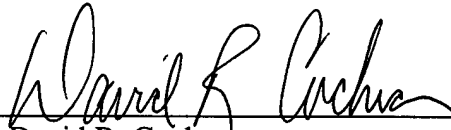
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Date 3 October 2005

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of October, 2005.

KACIA LEE

Name

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Signature